(28)

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 851.

JACK SHILKRET,

Respondent,

v.

MUSICRAFT RECORDS, INC.,

Petitioner.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

HERBERT M. KARP,
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THE COURT PRESS, N. Y. C.

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CASES CITED:

STATUTES AND AUTHORITIES CITED:

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Opinions Below.

The opinion in the Circuit Court of Appeals for the Second Circuit is reported in 131 Fed. (2nd) 929 (R., pp. 25-30). The opinion in the District Court is reported in 43 F. Supp. 184.

Jurisdiction.

The judgment of the Circuit Court of Appeals for the Second Circuit was entered December 29th, 1942. The petition for a writ of certiorari was filed March 25th, 1943. Jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended (U. S. C. A. Title 28, Sec. 347).

Question Presented.

Whether a work copyrighted under Section 11 of the Copyright Law (U. S. C. A., Title 17) and not reproduced in copies for sale is entitled to the protection in respect of mechanical royalties concededly accorded to works published and copyrighted after July 1, 1909.

Statutes Involved.

The pertinent provisions of the Copyright Law appear in the brief.

Statement.

This is an action under the Copyright Law of 1909. The complaint alleges that the respondent composed a new arrangement of "Southern Roses Waltz" by Johann Strauss and that the said arrangement was registered under Section 11 of the Copyright Act of 1909, as amended, and that a copyright issued to the respondent in said work. The complaint further alleges the petitioner caused the said work to be recorded mechanically and that such mechanical recordation was an infringement of respondent's copyright (R., pp. 3-11).

Petitioner moved under Rule 12 (b) F. R. C. P. to dismiss the complaint contending that an unauthorized mechanical recordation of a work copyrighted under Section 11 of the Copyright Act, as amended, does not constitute copyright infringement (R., p. 2). Petitioner's motion was granted by the District Court which dismissed the complaint for failure to state a cause of action (R., pp. 20-21). The Circuit Court of Appeals for the Second Circuit reversed the lower court's decision (R., pp. 25-30).

Argument.

Deposit of a work not reproduced for sale in the Library of Congress to effectuate a copyright under Section 11 of the Act (U. S. C. A. Title 17) is a publication of the work.

Section 11 of the Copyright Act states:

> "That copyright may also be had of the works of an author of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work, if it be a * * * musical * * * composition * * *. But the privilege of registration of copyright secured hereunder shall not exempt the copyright proprietor from the deposit of copies, under Sections twelve and thirteen of this Act, where the work is later reproduced in copies for sale."

The basis of the petition for a writ of certiorari in this matter is the contention that a work copyrighted under Section 11 *supra* (it is not claimed the copyright was secured prior to July 1, 1909) is a copyright in an "unpublished" work and is therefore not protected under Section 1 (e)[1] of the Act which

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[1] "Section 1. (Exclusive Rights in copyrighted works.) That any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:

* * *

(e) To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced; PROVIDED, that the provisions of this title, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after July 1, 1909 * * *"

accords protection for mechanical recordations of copyrighted works. It should be noted that "publication" of a work may take many forms other than the sale of copies to the public. It is the latter type of publication which is specifically differentiated by Section 11.

In Section 11, *supra,* no mention is made of "unpublished" or "published" works but the Section and the entire Act, in fact, was enacted to promote the arts and to grant copyright protection to one who registers a manuscript in the Library of Congress open to the inspection of the public.

The Copyright Act of 1909 fixed only one method of securing copyright,—publication with notice of copyright as differentiated from the old law which required the deposit of copies prior to the grant of a copyright.[2]

What a "publication" is and what constitutes sufficient publication to secure a copyright under the Copyright Act of 1909, as amended, has been determined many times by our Courts.

A publication is a disclosure of a work to the public, a notification to the people at large by writing.[3]

The test of "publication" is a determination of whether

> "* * * the delivery assured that the public, or an indefinite portion of it, should, without further

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[2] *Washingtonian Pub. Co., Inc.* v. *Pearson et al.*, 306 U. S. 30, 59 S. Ct. 397 (1939); Weil, "Copyright Law", 1917, p. 270; Committee Report on Bill Enacting Copyright Law of 1909, 60th Congress, 2nd Sess. #2222 states in discussing Section 9 of the Act: "It is proposed under this bill to so change this as to have the copyright effective upon the publication with notice, and the other formalities become conditions subsequent."

[3] Webster's Universal Dictionary (1936), Volume 2.

action on the part of the author, have access to it."[4]

The Copyright Act, Section 58, expressly provides that

> "all works deposited and retained in the Copyright Office shall be open to public inspection."

The view that deposit of a work in a public office is a publication, and deposit of a work in the Library of Congress to effectuate copyright constitutes a publication of the work, has been considered and approved by the Courts and authorities. In *Stern et al.* v. *Jerome H. Remick & Co.,* 175 Fed. 282 (1910), at page 284, the Court, referring to what constitutes a publication, stated:

> "Certainly, under this language, either the deposit, or the sale of the single copy to Ditson, was a publication"

and 18 C. J. S. 190, Sec. 66, in discussing what constitutes publication under the Act, says:

> "The deposit of copies of the work in the office of the librarian of Congress is a sufficient publication * * *."

In *Patterson* v. *Century Productions, Inc., et al.,* 93 F. (2d) 489 (1937), the Court, approving the decisions in *Universal Film Mfg. Co.* v. *Copperman,* 218 Fed. 577, and *Cardinal Film Corp.* v. *Beck et al.,* 248 Fed. 368, stated at page 491:

> "No publication was necessary other than the

[4] *Ladd* v. *Oxnard,* 75 Fed. 703, at pages 730, 731; see also *Jewelers' Mercantile Agency* v. *Jewelers' Publishing Co.,* 155 N. Y. 241; *Weil,* supra, page 150, #387.

deposit required by the statute as a prerequisite to validity."

Weil, in Law of Copyright, page 303, Section 780, states:

> "It is deemed, however, that under a proper reading of the language of this section (17 U. S. C. A., 11) it may well be held that the publication requisite may be contemporaneous with registration, that is to say, that the deposit of the prescribed copy in the Copyright Office is sufficient publication and that, if there has been no prior publication, the copyright will date from the time of deposit of the copy."[5]

In the case of *Marx et al.* v. *United States*, 96 Fed. (2d) 204 (1938), C. C. A. 9, the Court found no difficulty in determining that a work not reproduced in copies for sale is published within the Act and in determining the date of such publication. The Court, in a well reasoned opinion by Circuit Judge Healey, concluded that the Copyright Act limited all copyright to 28 years with a renewal for 28 more years and that under Section 23 of the Act,[6] the date of the first publication of the works, of which copies are not reproduced for sale, is the date of deposit in the Copyright Office.

The intent of Congress in granting mechanical protection to copyrighted works under Section 1 (e),

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[5] See also *Ladd* v. *Oxnard*, *supra*; *Callaghan* v. *Myers*, 128 U. S. 617, *Weil*, *supra*, pages 292, 293, #774, also, page 128, #324, and cases cited; Howell, "The Copyright Law", page 105

[6] 17 U. S. C. A. Section 23:

> "That the copyright secured by this title shall endure for twenty-eight years from the date of first publication * * *"

supra, of the Copyright Law of 1909 is clear and to give full meaning to the proviso contained therein one must look to the many Congressional hearings held before the Copyright Law of 1909 was enacted.

The case of *White-Smith Music Publishing Company* v. *Apollo*, 209 U. S. 1, decided February 1908, was in progress of litigation during the hearings which commenced in 1906. In that case the Supreme Court of the United States, construing the Copyright Act of March 3, 1891, held that mechanical reproduction was not one of the rights which flowed from the limited monopoly granted to creators of copyrighted works. Section 1 (e) was inserted in the Copyright Act to remedy this omission, yet the petitioner now claims that the purpose and intent of Congress was not achieved and should be defeated.

The sole reason for insertion of the phrase "* * * published and copyrighted after July 1, 1909 * * *" (the effective date of the Act) in Section 1 (e) was to stress the non-retroactivity of the rights granted to copyright owners.[7]

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[7] 17 U. S. C. A. Section 1 (e). Although the Committee Report on the Copyright Act, Committee Report on Bill Enacting Copyright Law of 1909, 60th Congress, 2nd Session, #2222 does not discuss the retroactivity of the proviso, at the Hearings before the Committee on Patents of House of Representatives cojointly with the Senate Committee on Patents on H. R. 19853, June 6, 7, 8 and 9, 1906 at page 96, the following colloquy between Nathan Burkan, Esq., and Chairman Currier of the House of Representatives' Committee and Representative Chaney:

"Mr. Currier: I do not think you need spend much time in talking about subsisting copyrights.

"Mr. Burkan: The intent of this act is to make it apply to compositions copyrighted after this act goes into effect.

* * *

"Mr. Chaney: It can be readily modified to suit that

[Footnote continued on following page.]

The Circuit Court, speaking through Swan, *Cir. J.*, states (R., p. 28):

> "No intelligible reason can be suggested why Congress should wish to forbid mechanical reproducers to infringe copyrighted works which had been published, but allow them to copy those which had not."

The soundness of this view is questioned but not answered by petitioner, who dismisses this equitable and entirely logical conclusion by terming it "a journey into the nebulous fields of Congressional intent * * *" (Pet.'s Brief, p. 9).

The Supreme Court of the United States, in the case of *Harrison* v. *Northern Trust Co. et al.*, 63 S. Ct. 361, decided January 11, 1943, said at page 363:

> "But words are inexact tools at best and for that reason there is wisely no rule of law forbidding resort to explanatory legislative history no matter how 'clear the words may appear on "superficial examination."' *United States* v. *Trucking Ass'ns*, 310 U. S. 534, 543, 544, 60 S. Ct.

[Footnote continued from preceding page.]

(only to composition copyrighted after this act goes into effect). There is not any question that we do not want to make it retroactive."

See also pages 100, 101 of the Hearings for colloquy between Mr. Davis and Representative Webb. No limitation was discussed against so-called "unpublished" works, but all references as to protection to be granted by the action 1 (e) are to "copyrighted" works. See also Committee Report #2222, *supra*, under Section 1 (e) of the Act in which the Committee refers time and time again to the protection to be granted to composers and copyright owners of "copyrighted" works.

1059, 1063, 1064, 84 L. Ed. 1345." (See *United States* v. *Trucking Ass'ns, supra*, 310 U. S. 534 at pp. 543, 544 and cases cited therein.)

The further characterization by petitioner of the decision of the Circuit Court as being an interpretation not of what Congress meant but what the Circuit Court believed it should have said is comprehensible only when one realizes that even the petitioner can not divine any reason why less protection should be accorded to a copyright secured under Section 11 than that for one granted under Section 12.

The construction of the Copyright Law desired by petitioner would create the first distinction, by any Copyright Act of any Country, between the rights granted to statutory copyrights. The true intent of Congress in enacting the Copyright Act of 1909, including Section 1(e) was to dispense with the inequalities and inequities which arose under the previous Copyright Acts with the result that copyright owners and writers received no compensation whatsoever for mechanical recordations of their creations. The Committee Hearings, of which at least 60% relate to arguments concerning mechanical recordings under the Act, definitely show an intent to protect each and every copyright owner under the Act and no distinction is made at any time in the hearings or in the Committee Report #2222, *supra*, between copyrights in works reproduced for sale and in works not reproduced for sale.

Reference is made (Pet.'s Brief, p. 10) to Section 2 of the Copyright Act and its application to unpublished works. It is elementary that Section 2 refers to common law copyrights only and that after the

receipt of a statutory copyright, be is under Section 11 or Section 12, one secures his rights and remedies only under the Copyright Act.

CONCLUSION.

The decision below is correct and does not warrant further review. The petition should therefore be denied.

Respectfully submitted,

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Attorney for Respondent.